

REMARKS

Claims 20, 22-33 and 35 are pending in the application. Claim 17-19, 21 and 34 have been canceled without prejudice and the Applicants' right to prosecute these claims in a timely-filed continuation application. Claims 20, 22, 23, 26, 28, 30 and 33 have been amended. The amendments to claims 20 and 22 re-draft the claims in independent form to incorporate the limitations from claim 17 from which they depend. The amendments to claims 23, 26, 28, 30 and 33 merely change the dependency of these claims from claim 17, which has been canceled, to claims 20 or 22. As such, these amendments should require no more than a cursory review by the Examiner.

In review of the following remarks, reconsideration and withdrawal of the rejections to the application in the Office Action is respectfully requested.

I. Rejection of Claims Under 35 U.S.C. § 112

The Examiner rejected claims 17-35 under 35 U.S.C. § 112, first paragraph, asserting that these claims are not described in such a way as to enable one skilled in the art to make or use the invention. In support of this rejection, the Examiner focused on independent claim 17. Citing the phrase "up to 95% by weight of an aqueous phase" the Examiner characterizes claim 17 as "broadly drawn to applying any and all lubricating oils to a conveyor belt surface which produces a dry lubricant film." Applicants respectfully disagree with the Examiner's conclusion that the pending specification is insufficient to enable the scope of claim 17. However, in order to expedite the prosecution of this application, Applicants have canceled claim 17. Applicants also respectfully note, however, that the Examiner's rejection is inapplicable to the remaining claims, particularly claims 20, 22 and 35, because the Examiner has failed to consider the additional limitations introduced by those claims.

Claim 20 recites a method for lubricating a conveyor belt using a liquid composition comprising an aqueous phase and 10 to 40% by weight of a silicone oil, the silicone oil being a polydimethyl siloxane. Thus, claim 20 is not broadly drawn to a method of applying "any and all

lubricating oils to a conveyor belt surface which produces a dry lubricant film,” as asserted by the Examiner. Claim 22 recites a method for lubricating a conveyor belt surface using a liquid composition comprising 10 to 90% by weight of an oil selected from vegetable oils, mineral oils, and mixtures thereof, and 10 to 50% by weight of water. Thus, like claim 20, claim 22 is not broadly drawn to a method of applying “any and all lubricating oils to a conveyor belt surface which produces a dry lubricating film.” The subject matter of claims 20 and 22 is sufficiently enabled by the pending application. For example, an enabling disclosure for claim 20 may be found in the specification on page 6, line 15 through page 7, line 11, and in Example 1 on page 15, which provides a composition having the characteristics recited in claim 20. An enabling disclosure for claim 22 may be found on page 7, line 13 through page 8, line 7 and in Example 2 on page 15 which recites a composition having the characteristics recited by claim 22. Therefore, Applicants respectfully assert that there is a reasonable correlation between the scope of claims 20 and 22 and the scope of the enablement set forth in the patent application, and respectfully request that this rejection be withdrawn.

Claim 35 recites a method for lubricating a conveyor belt surface using a flicker non-contact applicator containing a motor-driven rotating tubular brush and a steel plate mounted against the brush which flicks the bristles as the brush rotates. The Examiner’s statement that “the specification is not enabled for applying a composition ‘comprising’ all known lubricating oils to a conveyor belt surface that produces a dry lubricant film” is simply inapplicable to claim 35 of the pending application. Therefore, Applicants respectfully request that this rejection be withdrawn.

II. Rejection of Claims Under 35 U.S.C. § 103(a)

Claims 17-20 and 35 were rejected in the Office Action under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 4,149,624 issued to Douty et al. (hereinafter “Douty”). Claims 17-19 have now been canceled, and therefore, need not be addressed. With respect to claims 20 and 35, Applicants respectfully traverse.

In order to establish a *prima facie* case of obviousness under 35 U.S.C. § 103, the cited reference must teach or suggest each and every limitation of the rejected claims. Douty does not render claim 20 of the pending application unpatentable because Douty fails to teach a method for lubricating a conveyor belt surface using a liquid composition comprising 10 to 40% by weight of a silicone oil. In support of the rejection, the Examiner stated:

Douty et al ["Douty"] disclose a method of applying a water based silicone emulsion onto a conveyor belt surface. The silicone fluid may be dimethyl polysiloxane and the emulsion is manufactured having a 35% silicone fluid content.

While it may be true that the silicone fluid disclosed by Douty was manufactured having a 35% silicone fluid content, the silicone emulsion spray that is applied to the conveyor belt surface in Douty has a much lower silicone fluid content, because the silicone fluid is heavily diluted with water prior to application in the methods disclosed by Douty. (*See, e.g.*, Col. 5, lines 36-40.) In fact, Douty teaches that the amount of silicone fluid in the applied solution is generally between 0.15% and 0.50%. (*See* Col. 8, lines 15-18.) Moreover, Douty actually teaches away from compositions having a silicone content substantially outside the cited range, stating that solutions containing between 0.1% and 0.8% silicone represent extremes and are not generally applicable in the majority of circumstances. (*See* Col. 9, lines 46-51.) Douty also teaches that keeping the percentage of silicone in the applied solutions low is important in achieving effective water repellency at low cost. (*See* Col. 10, lines 22-28.) Therefore, Douty fails to teach or suggest a method for lubricating a conveyor belt surface by applying a liquid composition comprising 10 to 40% by weight of a silicone oil. For this reason, Applicants respectfully request that the rejection of claim 20 be withdrawn.

Claim 35 recites a method for lubricating a conveyor belt surface using a flicker non-contact applicator that includes a motor-driven rotating tubular brush and a steel plate mounted against the brush which flicks the bristles as the brush rotates. Although the Examiner rejected claim 35 as unpatentable over Douty, the Examiner failed to point out and Applicants have failed to locate any language in Douty that teaches or suggests either element of the flicker non-contact

applicator recited in claim 35. Instead, Douty teaches a method wherein a liquid composition is sprayed onto a conveyor belt through one or more spray nozzles. (See Fig. 2 and Col. 5, lines 48-53.) Therefore, Douty fails to teach or suggest each and every limitation of claim 35 and Applicants respectfully request that this rejection be withdrawn.

In view of the foregoing remarks, Applicants respectfully submit that all of the claims remaining in the application are in condition for allowance and favorable action thereon is respectfully solicited.

Respectfully submitted,

Date August 13, 2003

FOLEY & LARDNER
Customer Number: 23524



23524

PATENT TRADEMARK OFFICE

Telephone: (608) 258-4305

Facsimile: (608) 258-4258

By

Michelle Manning
Michelle Manning
Attorney for Applicant
Registration No. 50,592